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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/687,228  | 10/16/2003  | Steven D. Culhane    | 02-200-US2                 | 9854                   |
| 34704 7590 11/14/2007<br>BACHMAN & LAPOINTE, P.C.<br>900 CHAPEL STREET<br>SUITE 1201<br>NEW HAVEN, CT 06510 |             |                      | EXAMINER<br>HOEY, ALISSA L |                        |
|   |             |                      | ART UNIT<br>3765           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>11/14/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/687,228

Applicant(s)

CULHANE, STEVEN D.

Examiner

Alissa L. Hoey

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The BPAI reversed the Examiner's rejections under 35 USC 102(b) to Kratz (US 4,722,099) and under 35 U.S.C. 112, first paragraph. In view of the BPAI decision rendered on 08/30/07, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final)', or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Gary Welch (SPE)

  
GARY L. WELCH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not define what the non-stretch material is made out of. All fabric have some degree of stretch and without providing examples of the "non-stretch" material the invention is not enabled. Materials either contain elastic-type material, which inherently makes them more stretchable than other materials, but due to the knitting/weaving construction of materials, all materials are stretchable. There is a difference between stretch/non-stretch and elastic/inelastic. The applicant is not claiming/disclosing that the fibers are elastic or inelastic, just that they are stretch and non-stretch. A material can be considered "non-stretchable" compared to another material, but it is not 100 % non-stretchable. In patent prosecution, usually a material with elastic is the stretch material and the inelastic/non-elastic material is the more stable "non-stretchable" material in comparison. Denim and duck canvas can be two non-elastic materials, however, due to their constructions, they are stretchable. Stretch is the ability to go from one measurement to a greater measurement, the term stretch does not have any definition in terms of returning back to the original measurement/shape. Any material can be stretched if enough force is applied, however, once stretched the material does not need to resort back to the original size and shape to be deemed stretchable. One not skilled in the apparel arts might mistake stretch and

non-stretch fabrics to be the same thing as elastic and inelastic fabrics, this however, by their definitions is not the case.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the non-stretch material is, since no material is fully non-stretch and the disclosure lacks any discussion on what the non-stretch material is.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Foo (US 5,168,580).

In regard to claims 10-14, Foo teaches the following:

Claim 10. A garment (10) to be worn by a human being comprising:

a front portion and a rear portion (figures 1-2);

a pair of arms (14, 12) being joined to said front and rear portions (figures 1-2);

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each of said arms (14, 12) having an outer elbow portion formed from a stretch fabric material (column 2, lines 30-44) and other portions (40, 16, 18, 20, 50) formed from a non-stretch fabric material (column 2, lines 65-68); and underarm portions (12, 14) formed from a stretch fabric material (column 2, lines 30-44).

Claim 11. (original) A garment according to claim 10, wherein the rear portion has at least one portion formed from a stretch fabric material (figure 2; column 2, lines 30-44).

Claim 12. (original) A garment according to claim 10, wherein the rear portion has first and second side portions and a central portion and wherein each of said first and second side portions is formed from a stretch fabric material (figure 2; column 2, lines 30-44).

Claim 13. A garment according to claim 12, wherein said central portion (50) is formed from a non-stretch fabric material (column 2, lines 65-68).

Claim 14 A garment according to claim 10, further comprising a liner within the garment (column 2, lines 30-44).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foo in view of Blauer et al. (US 5,593,754).

Foo provides a garment as described above in claims 10 and 14. However, Foo fails to teach a liner having a stretch fabric material layer and an adjacent stretch film material layer and the liner being breathable and stretchable.

In regard to claims 15 and 16, Blauer et al. provides a garment having a liner formed of a breathable waterproof stretch fabric material and an adjacent stretch film material layer next to the stretch fabric material layer (figures 3 and 4, identifiers 22, 24, 30, 32 and 34: column 8, lines 5-19).

It would have been obvious to have provided the outer garment of Foo with the liner of Blauer et al., since the garment of Foo provided with a dual liner with stretchable film and fabric would provide the outer garment with superior breathability, water fastness and stretchability keeping the user dryer, cooler, more comfortable.

9. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foo in view of Lipson (US 2,002,955).

Foo provides an outer garment as described above in claim 10. However, Foo fails to teach the outer garment having a hood that is detachable and collapsible to the outer garment.

Lipson provides an outer garment having a hood that is detachable and collapsible to the outer garment (figures 1-6, identifiers 2, 10, 12, 6 and 8: page 1, column 2, lines 12-45).

It would have been obvious to have provided the outer garment of Foo with the hood of Lipson, since the outer garment of Foo having a detachable and collapsible

hood would provide the user with a hood that can protect the wearer's head from the elements and can also be detached and stored when not needed by the wearer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALH

/Alissa L. Hoey/  
Primary Examiner, Art Unit 3765

|                                   |                                       |  |  |             |
|-----------------------------------|---------------------------------------|--|--|-------------|
| <b>Notice of References Cited</b> | Application/Control No.<br>10/687,228 |  | Applicant(s)/Patent Under<br>Reexamination<br>CULHANE, STEVEN D. |             |
|                                   | Examiner<br>Alissa L. Hoey            |  | Art Unit<br>3765   | Page 1 of 1 |

**U.S. PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Name          | Classification |
|---|---|--|-----------------|---------------|----------------|
| * | A | US-5,168,580                                     | 12-1992         | Foo, Ian      | 2/115          |
| * | B | US-5,097,535                                     | 03-1992         | Dye et al.    | 2/69           |
| * | C | US-5,799,328                                     | 09-1998         | Harlem et al. | 2/69           |
| * | D | US-6,349,413                                     | 02-2002         | Rose et al.   | 2/126          |
|   | E | US-  |                 |               |                |
|   | F | US-  |                 |               |                |
|   | G | US-  |                 |               |                |
|   | H | US-  |                 |               |                |
|   | I | US-  |                 |               |                |
|   | J | US-  |                 |               |                |
|   | K | US-  |                 |               |                |
|   | L | US-  |                 |               |                |
|   | M | US-  |                 |               |                |

**FOREIGN PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Country | Name | Classification |
|---|---|--|-----------------|---------|------|----------------|
|   | N |  |                 |         |      |                |
|   | O |  |                 |         |      |                |
|   | P |  |                 |         |      |                |
|   | Q |  |                 |         |      |                |
|   | R |  |                 |         |      |                |
|   | S |  |                 |         |      |                |
|   | T |  |                 |         |      |                |

**NON-PATENT DOCUMENTS**

| * |   | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
|   | U |   |
|   | V |   |
|   | W |   |
|   | X |   |

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.